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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,356	03/31/2004	Mark S. Zeiner	END5008USCIP2	8274
27777	7590	12/23/2010	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			YABUT, DIANE D	
			ART UNIT	PAPER NUMBER
			3734	
			NOTIFICATION DATE	DELIVERY MODE
			12/23/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jnjuspatent@corus.jnj.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/815,356	<b>Applicant(s)</b> ZEINER ET AL.	
	<b>Examiner</b> DIANE YABUT	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06/09/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-11,17,19,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-11,17,19,23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/06/10</u>  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to applicant's pre-brief appeal conference request received on 06/09/2010. Prosecution has reopened as indicated in the pre-brief appeal conference decision filed 09/21/2010. Upon further consideration, a new ground(s) of rejection are made below.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 04/06/2010 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Objections***

3. Claim 23 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 23 recites that the "plurality of elastomeric layers are interwoven" and depends on Claim 17 which already recites "the elastomeric members circumscribing an aperture in an interwoven pattern."

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Smith et al.** (U.S. Patent No. **5,603,702**) in view of **Rowe et al.** (U.S. Patent No. **5,342,315**).

Smith et al. disclose a hollow cannula **200** having a distal end and a proximal end, a housing **100** having a distal end attached to said proximal end of said cannula and a proximal end having a wall attached thereto, said wall having an aperture therethrough (Figure 1); an instrument seal assembly **110** disposed within said housing comprising a first substantially rigid ring **108**, a second substantially rigid ring **112**, and an elastomeric, non-planar instrument seal **128** compressed between said rings being adapted to sufficiently seal against instruments positioned through the seal to maintain gas pressure in the abdominal cavity during endoscopic surgical procedures and forming a centrally located aperture **130** in said seal assembly (Figures 2-4), a zero closure valve or duck bill seal **208** disposed distally of and spaced from the instrument seal **110**, the zero closure seal operable to provide a seal in absence of an instrument positioned through the housing (Figure 11). The instrument seal has a proximal flange portion **132** and an inwardly extending portion **128** wherein said proximal flange portions are disposed between and are abutting against said rings (Figures 2A-4) and a seal

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assembly having an outer perimeter which is attached to a flotation means ("bellows structure") **134** (Figures 14-15) and a plurality of protectors **140** disposed proximal to said elastomeric seal (Figures 2A, 5, 11, col. 6, lines 51-62).

Smith et al. fail to disclose the instrument seal comprising a plurality of separate semicircular seal segments, each seal segment having a circumference greater than 180 degrees and having a non-planar shape prior to being assembled together.

Rowe et al. teach a plurality of separate semicircular seal segments **168**, each seal segment having a circumference greater than 180 degrees and having a non-planar shape prior to being assembled together (Figures 7-10; col. 9, lines 1-38). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a plurality of separate semicircular seal segments, each seal segment having a circumference greater than 180 degrees and having a non-planar shape prior to being assembled together, as taught by Rowe et al., to Smith et al. in order to provide a further flexible and effective seal that has seal segments that may pivot proximally and distally to facilitate introduction of instruments (col. 2, lines 16-34).

6. Claims 9-11, 17, 19, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Smith et al.** (U.S. Patent No. **5,603,702**) in view of **Haber et al.** (U.S. Patent No. **5,385,552**).

Smith et al. disclose a hollow cannula **200** having a distal end and a proximal end, a housing **100** having a distal end attached to said proximal end of said cannula and a proximal end having a wall attached thereto, said wall having an aperture therethrough

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(Figure 1); an instrument seal assembly **110** disposed within said housing comprising a first substantially rigid ring **108**, a second substantially rigid ring **112**, and an elastomeric, non-planar instrument seal **128** compressed between said rings being adapted to sufficiently seal against instruments positioned through the seal to maintain gas pressure in the abdominal cavity during endoscopic surgical procedures and forming a centrally located aperture **130** in said seal assembly (Figures 2-4), a zero closure valve or duck bill seal **208** disposed distally of and spaced from the instrument seal **110**, the zero closure seal operable to provide a seal in absence of an instrument positioned through the housing (Figure 11). The instrument seal has a proximal flange portion **132** and an inwardly extending portion **128** wherein said proximal flange portions are disposed between and are abutting against said rings (Figures 2A-4) and a seal assembly having an outer perimeter which is attached to a flotation means ("bellows structure") **134** (Figures 14-15) and a plurality of protectors **140** disposed proximal to said elastomeric seal (Figures 2A, 5, 11, col. 6, lines 51-62). Smith et al. also disclose a plurality of protrusions **132**, **135** connecting the first and second rings and the elastomeric members (Figure 11).

Smith et al. fail to disclose the instrument seal comprising a plurality of layered, semicircular members arranged circumferentially about an aperture in an interwoven, alternating over and under pattern and having a non-planar shape prior to being assembled together.

Haber et al. teach a plurality of layered, semicircular members **126** being arranged circumferentially about an aperture in an interwoven, alternating over and

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under pattern and having a non-planar shape prior to being assembled together (Figures 2 and 5A). It would have been obvious to one of ordinary skill in the art at the time of invention to provide a plurality of layered, semicircular members arranged circumferentially about an aperture in an interwoven, alternating over and under pattern and having a non-planar shape prior to being assembled together, as taught by Haber et al., to Smith et al. in order to improve sealing flexibility and effectiveness (col. 2, lines 33-44).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-6, 8-11, 17, 19, 23, 24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIANE YABUT whose telephone number is (571)272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Diane Yabut/  
Examiner, Art Unit 3734

/TODD E. MANAHAN/  
Supervisory Patent Examiner, Art Unit 3776